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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,055	02/07/2001	Yuichi Asami	Q62904	7352

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EXAMINER

CAPRON, AARON J

ART UNIT PAPER NUMBER

3714

DATE MAILED: 03/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/778,055

Applicant(s)

ASAMI ET AL.

Examiner

Aaron J. Capron

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This is a response to the Amendment received on December 20, 2002, in which claims 1, 7-8, 10-11, 14-22 and 25-32. Claims 1-35 are pending.

#### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 7-12, 14-23, 25-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Araki et al. (US Publication No. 2002/0094865; hereafter "Araki").

Araki discloses a game machine that includes first original music output means for outputting during automated game play at least a main part of first original music containing the main part (Figure 7: First-Fourth Channel from t0 to t1) and a post-amble subsequent thereto (Figure 7: First-Fourth Channel from t1 to when the background-sound data of each channel=0); a second original music output means for outputting during automated game play at least a main part of second original music containing a preamble (Figure 7: Fifth-Sixth Channel from t1-t3) the main part subsequent thereto (Figure 7: Fifth-Sixth Channel from t3-beyond); connection music output means for outputting during automated game play predetermined connection music (Figures 5-7; Figure 7: First-Sixth Channel from t1-t3); timing control means for controlling during automated game play the second music output means and the connection music output

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means such that main part end timing of the original music coincides with start timing of the connection music, and the main part start timing of the second original music coincides with output with output end timing of the connection music (Figure 5).

Referring to claims 2 and 3, Araki discloses the ability to adjust the volume (Figure 5 and 7: 6:94).

Referring to claims 7-9, Araki discloses a game machine that has the ability to storing audio data (2:22)

Referring to claim 10, Araki discloses a game machine that has original music storage means, original music end timing storage means, connection music storage means (2:22-23), original music reproduction means, main part end timing monitoring means, connection music output means and volume control means (Figures 5 and 7).

Referring to claims 11 and 12, Araki discloses a game machine that has original music storage means, main part start timing storing means, connection music storage means, original music reproduction start timing storage means, connection music output means, original music reproduction start timing monitoring means, original music reproduction means, main part start timing monitoring means and volume control means (Figures 5 and 7), the volume not adjusting as the music is reproduced.

Claims 14-15 correspond in scope to a method set forth for use of the game machine listed in claims listed above and are encompassed by use as set forth in the rejection above.

Claims 16-18 correspond in scope to an information storage medium set forth for use of the game machine listed in claims listed above and are encompassed by use as set forth in the rejection above.

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Claims 19-20 correspond in scope to a distribution device set forth for use of the game machine listed in claims listed above and are encompassed by use as set forth in the rejection above.

Claims 21 correspond in scope to a game machine set forth for use of the game machine listed in claims listed above and are encompassed by use as set forth in the rejection above.

Referring to claim 22, Araki discloses a game machine of which controller is operated by a player in accordance with game music, the machine including input means for setting a play conditions, storage means for storing the play conditions and game advancing means for advancing a game according to the play condition stored wherein the game advancing means includes the ability to output music relating to the game.

Referring to claim 23, Araki discloses the game advancing means further comprises timing guidance image display means for displaying timing guidance image in conformity with the play condition stored in the play condition storage means, for guiding timing at which the player is to operate the controller in accordance with the game music (7:114-player has to kill more opponents once the volume of music switches back and forth).

Claims 25-29 correspond in scope to a game machine set forth for use of the game machine listed in claims listed above and are encompassed by use as set forth in the rejection above.

Claims 30-32 correspond in scope to a computer readable storage medium set forth for use of the game machine listed in claims listed above and are encompassed by use as set forth in the rejection above.

Claim13 is rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki. This holding is maintained from prior action for cited claims, which is incorporated herein.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Araki.

Referring to claim 24, Araki discloses a game machine of which controller is operated by a player in accordance with game music, the machine including input means for setting a play conditions, storage means for storing the play conditions and game advancing means for advancing a game according to the play condition stored wherein the game advancing means includes the ability to output music relating to the game, the ability to change and control the music in real time based upon player's preferences by adjusting the music editor, but does not disclose that the original music determination means determines the original music to output based on a random number. However, it is notoriously well known in the art to use random music in order to update the game so the sound does not create redundancy in the game. The random generation of sound could ensure that the game would create interest in the game for a longer period of time. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the random generation of the music to

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Araki's invention in order to create a game that is non-repetitive in nature and therefore, could keep player's attention for a longer time period.

Claims 4-6 and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Araki in view of Sone (U.S. Patent No. 5,919,047).

Araki discloses a game machine that allows for smooth switching between the background sound data to be outputted through the speaker (7:106,108), but does not specifically disclose that the smooth switching of the background music involves tempo matching. However, Sone discloses that in order to ensure a smooth transition from a first piece of music to a second piece of music, the device uses cross-fading for the volume and the tempo (Figure 7B; 9:23-52). One would be motivated to combine the references in order ensure that the listener does not hear any unnatural changes between the two songs. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the tempo matching means of Sone into Araki's game in order to ensure that the listener does not hear any unnatural changes between the two songs.

#### *Response to Arguments*

Applicant's arguments with respect to claims 1-35 have been considered but are moot in view of the new ground(s) of rejection.

#### *Conclusion*

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



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ajc

February 27, 2003

A handwritten signature in black ink, appearing to read 'S. Thomas Hughes', is written over a printed nameplate.

S. THOMAS HUGHES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700